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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,328	01/20/2006	Alois Maier	HUBR-1291	2248
24972 7590 04/14/2009 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198				
EXAMINER				
NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1796				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/565,328

Applicant(s)

MAIER ET AL.

Examiner

Patrick D. Niland

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-36, 38-45 and 47-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-36, 38-45, and 47-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The amendment of 1/23/09 has been entered. Claims 26-36, 38-45, and 47-56 are pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 26-36, 38-45, and 47-56 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6462127 Ingrisich et al..

Ingrisich discloses the instantly claimed polyurethane dispersions at the abstract; column 1, lines 4-67; column 2, lines 1-67; column 3, lines 1-67, particularly 44-67 which broadly encompasses the instantly claimed invention; column 4, lines 1-67, particularly 18-67, which encompasses the instantly claimed ingredients and amounts thereof. It is noted that the instant claim recites ">12" regarding component A and the disclosure's preferred amount of the instantly claimed component A is 0.3-12%. However, the amount of the patentee is based on the amount of their component H. Before addition of the patentee's component H, the patentee's component A is present in a greater amount than when H is added, e.g. consider the patentee's 12% of A which gives $12/(88 \text{ of all components but A} + 12 \text{ of A})$ and removal of the lower amount of H of the patentee, i.e. 5% which gives $12/((88-5) + 12)$ which is about 12.6% of A.

Removing larger amounts of the patentee's H and using 12% of the instantly claimed A in the patentee's compositions clearly gives even larger amounts of A in the patentee's compositions, which meets the instant claims using more than 12% of the instantly claimed component A. Thus, the intermediate of the patentee prior to addition of their component H has the instantly claimed amount of A. The ingredients of column 5, lines 1-8 are additional to those of the instant claims. Taking the amounts of column 5, lines 1-8 of the patentee from the patentee's composition and using the larger amounts of the instantly claimed component A of the patentee gives amounts within those of the instant claims since removing the amounts of column 5, lines 1-8 lowers the amount of the denominator used to calculate the amounts. Furthermore, the amounts overlap due to experimental error in making such measurements and because the broader disclosure of the patentee encompasses larger than the preferred amounts of the instantly claimed component A. Note also column 5, lines 9-67; column 6, lines 1-67, column 7, lines 1-67; column 8, lines 1-67; column 9, lines 1-67; column 10, lines 1-19, which encompasses the instantly claimed high molecular weight; column 11, lines 18-67; column 12, lines 1-67, particularly the method steps and temperatures which fall within the scope of those of the instant method claims; column 13, lines 1-44 which discloses the instantly claimed substrates; and the remainder of the document which encompasses the limitations of the remaining claims, particularly the examples and the claims.

The instant claim 47 is a method that recites "comprising" and therefore includes the addition of other ingredients due to the open nature of the claim. The instant claims which continue to recite open language continue to encompass the additional components of the patentee. Column 11, lines 31-48, particularly 44-48 show that the polyurethane dispersion not containing H and I

of the patentee is prepared and exists for a finite period of time without the presence of H and I of the patentee. This existence meets the requirements of the instant claim 52 in that the intermediate does not contain anything excluded by the recitations of "consisting" of the instant claims.

The applicant's arguments have been fully considered but are not persuasive for the reasons stated above. The rejection is maintained for the above reasons.

5. Claims 26-36, 38-45, and 47-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6462127 Ingrisich et al..

Ingrisich discloses the instantly claimed polyurethane dispersions at the abstract; column 1, lines 4-67; column 2, lines 1-67; column 3, lines 1-67, particularly 44-67 which broadly encompasses the instantly claimed invention; column 4, lines 1-67, particularly 18-67, which encompasses the instantly claimed ingredients and amounts thereof. It is noted that the instant claim recites ">12" regarding component A and the disclosure's preferred amount of the instantly claimed component A is 0.3-12%. However, the amount of the patentee is based on the amount of their component H. Before addition of the patentee's component H, the patentee's component A is present in a greater amount than when H is added, e.g. consider the patentee's 12% of A which gives $12/(88 \text{ of all components but A} + 12 \text{ of A})$ and removal of the lower amount of H of the patentee, i.e. 5% which gives $12/((88-5) + 12)$ which is about 12.6% of A. Removing larger amounts of the patentee's H and using 12% of the instantly claimed A in the patentee's compositions clearly gives even larger amounts of A in the patentee's compositions, which meets the instant claims using more than 12% of the instantly claimed component A. Thus, the intermediate of the patentee prior to addition of their component H has the instantly

claimed amount of A. The ingredients of column 5, lines 1-8 are additional to those of the instant claims. Taking the amounts of column 5, lines 1-8 of the patentee from the patentee's composition and using the larger amounts of the instantly claimed component A of the patentee gives amounts within those of the instant claims since removing the amounts of column 5, lines 1-8 lowers the amount of the denominator used to calculate the amounts. Furthermore, the amounts overlap due to experimental error in making such measurements and because the broader disclosure of the patentee encompasses larger than the preferred amounts of the instantly claimed component A. Note also column 5, lines 9-67; column 6, lines 1-67, column 7, lines 1-67; column 8, lines 1-67; column 9, lines 1-67; column 10, lines 1-19, which encompasses the instantly claimed high molecular weight; column 11, lines 18-67; column 12, lines 1-67, particularly the method steps and temperatures which fall within the scope of those of the instant method claims; column 13, lines 1-44 which discloses the instantly claimed substrates; and the remainder of the document which encompasses the limitations of the remaining claims, particularly the examples and the claims.

The instant claim 47 is a method that recites "comprising" and therefore includes the addition of other ingredients due to the open nature of the claim. The instant claims which continue to recite open language continue to encompass the additional components of the patentee. Column 11, lines 31-48, particularly 44-48 show that the polyurethane dispersion not containing H and I of the patentee is prepared and exists for a finite period of time without the presence of H and I of the patentee. This existence meets the requirements of the instant claim 52 in that the intermediate does not contain anything excluded by the recitations of "consisting" of the instant claims.

It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the ingredients and amounts thereof and the reaction parameters of the instant claims in making the dispersions of the patentee because these are encompassed by the disclosure of the patentee and would have been expected to give the properties of the dispersions of the patentee. It would have at least been obvious to one of ordinary skill in the art at the time of the instantly claimed invention to use the instantly claimed amounts of the instantly claimed component A in the dispersions of the patentee because using one % more than the upper level of the preferred amounts of the patentee that read on the amounts of the instant claims will not give a significantly different result and will give only predictable results to the ordinary skilled artisan, i.e. 12% to 13% is not expected to give much difference and is encompassed by the broad disclosure of the patentee as preferred mode does not teach away from other values and the broad disclosure encompasses broader values of the amount of A. The applicant's arguments have been fully considered but are not persuasive for the reasons stated above and the teachings of the patentee.

The applicant's arguments have been fully considered but are not persuasive for the reasons stated above. The rejection is maintained for the above reasons.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Friday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
Art Unit 1796

